APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/865,841	05/30/1997	JAKOB NIELSEN	2860-059-P22	8979

				EXAMINER
22852	7590	12/20/2004		COBY, FRANTZ

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20005

ART UNIT	PAPER NUMBER
2161	

DATE MAILED: 12/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Offic Action Summary	08/865,841	NIELSEN, JAKOB
	Examiner	Art Unit
	Frantz Coby	2161

-- The MAILING DATE f this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>10 May 2004</u>.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-26</u> is/are pending in the application.

　4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-26</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

　Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

　Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

　a)☐ All b)☐ Some * c)☐ None of:

　　1.☐ Certified copies of the priority documents have been received.

　　2.☐ Certified copies of the priority documents have been received in Application No. _____.

　　3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

　* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
　　Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
　　Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

This is in response to Applicant's amendment filed on May 10, 2004 in which claims 1,

4, 7, 13, 14, 18, 19, 20 and 23-25 were amended.

Status of Claims

Claims 1-26 are pending.

Applicant's arguments filed on the aforementioned date have been fully

considered but they are not persuasive. Therefore, the rejection of claims 1-26 mailed

on February 13, 2004 remains.

The rejection follows:

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-26 are rejected under 35 U.S.C. 102(e) as being anticipated by

Cochran U.S. Patent no. 5,995,979.

As per claim 1, Cochran discloses "a computer apparatus for information

retrieval" by providing a plurality of computers connected in a network (See Cochran

figure 1, components 720) including computer software that permit the accessing of

data from a computer database (See Cochran Col. 5, lines 40-42). As to the claimed

features of "a bus", this feature is primarily incorporated in the computers disclosed by

Cochran since a bus is a set of hardware lines or conductors used for data transfer

among the components of a computer system. Notice that "a processor" is inherent in a

computer" because it is the computational and control unit of a computer. As to the

claimed limitations of "a communication interface connected to the bus", Cochran

discloses that each computer (Figure 1 component 720) has memory space 717 and a

monitor device 725. It would be apparent that each of the computers of Cochran

includes an interface that connects pieces of hardware with the processor so that

information can be moved from place to place. Cochran has shown the claimed

limitations of "information storage accessible through the bus and containing stored

information" as a CD-ROM (See Cochran Col. 5, lines 39-41) and it is also apparent

that the CD-ROM would be connected to a bus to properly function with the processor.

As to a processor configured to "receive search queries" and "process those queries"

Cochran provides a mechanism such as computer software which permits the

accessing of data from a computer database" (See Cochran Col. 5, lines 40-41). In

particular, claim 1 recites a processor "to provide a list of terms used in the search

queries presented over a period of time to be selectively added to the stored

information" . Cochran discloses the aforementioned claimed limitations by providing a

method for managing the presentation of search terms on a computer wherein multiple

lists of search terms are displayed, a search is conducted based upon selected search

terms from one or more of the multiple search lists, also, the records identified by the

search is used to form new lists of search terms (See Cochran Abstract', Col. 4, lines 1-

57., Figure 2 and corresponding text).

As per claims 2-3, most of the limitations of these claims have been noted in the

rejection of claim 1 . Applicant's attention is directed to the rejection of claim 1 above.

In addition, Cochran disclose the claimed limitations of "a term to be selectively added

is

added to a document of file as a meta-tag"; by allowing entry to be made in the lists',

thus, updating the lists (See Cochran Col. 12, lines 54-56). Notice that the lists of

Cochran (See Cochran Figures 3-10b) are multi-element data structure that has a linear

organization that allows elements to be added or removed. Thus, when updating the

lists, entries are made in the multi-element data structure. The Applicant should duly

note that a meta-tag is described in the specification (page 1, lines 1 1-12) as an entry

in a meta-information section of a document or a file. As to the claimed feature of "a

term to be selectively added is also added to an inverted index" Cochran achieved this

limitation by providing lists of search terms where the lists can be updated (See

Cochran Figures 3-10b) Thus, It would be apparent from Cochran's use of updating lists

that terms must be added to an inverted index to effectively create alternative locators

for the search terms in the lists.

As per claim 4, Cochran discloses an information retrieval system" by providing a plurality of computers connected in a network (See Cochran figure 1, components 720) including computer software that permit the accessing of data from a computer database (See Cochran Col. 5, lines 40-42). In particular, Cochran discloses the claimed limitations of "a network"; "a plurality of users connected to said network" by providing a computer communication network (See Cochran Figure 1). Further, Cochran discloses the claimed features of "at least one server connected to said network, said sever providing search access to a plurality of documents and files stored on said server in response to search queries submitted by users" (See Cochran Col. 5, line 65- Col. 7, line 4). Last, Cochran discloses the claimed limitations of "said server configured to provide a list of terms used in search queries over a period of time to be selectively added to at least one of the stored items" by providing a method for managing the presentation of search terms on a computer wherein multiple lists of search terms are displayed, a search is conducted based upon selected search terms from one or more of the multiple search lists, also, the records identified by the search is used to form newlists of search terms (See Cochran Abstract', Col. 4, lines 1-57., Figure 2 and corresponding text).

As per claims 5-6, most of the limitations of these claims have been noted in the rejection of claim 4. Applicant's attention is directed to the rejection of claim 4 above.

In addition, Cochran disclose the claimed limitations of "a term to be selectively added

is added to a document of file as a meta-tag; by allowing entry to be made in the lists;

thus, updating the lists (See Cochran Col. 12, lines 54-56). Notice that the lists of

Cochran (See Cochran Figures 3-10b) are multi-element data structure that has a linear

organization that allows elements to be added or removed. Thus, when updating the

lists, entries are made in the multi-element data structure. The Applicant should duly

note that a meta-tag is described in the specification (page 1, lines 1 1-12) as an entry

in a meta-information section of a document or a file. As to the claimed feature of "a

term to be selectively added is also added to an inverted index" Cochran achieved this

limitation by providing lists of search terms where the lists can be updated (See

Cochran Figures 3-10b). Thus, It would be apparent from Cochran's use of updating list

that terms must be added to an inverted index to effectively create alternative locators

for the search terms in the lists.

As per claim 7, most of the limitations of this claim have been noted in the

rejection of claims 1 and 4 above. In addition, Cochran discloses the claimed feature of

providing an element for storing a list of queries" and "an element for storing a list

terms" by providing memory spaces for retaining search request (See Cochran Col. 6,

lines 40-52). Also, Cochran discloses the claimed limitations of "providing an element

for selecting" (See Cochran Col. 7, lines 48-54). Last, Cochran discloses the claimed

limitations of "processing each term of said portion for selectively addition to documents

or files stored in said systems as a meta-tag" by allowing entry to be made in the lists,

thus, updating the lists (See Cochran Col. 12, lines 54-56). Notice that the lists of

Cochran (See Cochran Figures 3-10b) are multi-element data structure that has a linear

organization that allows elements to be added or removed. Thus, when updating the

lists, entries are made in the multi-element data structure. The Applicant should duly

note that a meta-tag is described in the specification (page 1 , lines 1 1-12) as an entry

in a meta-information section of a document or a file.

As per claims 8-10, most of the limitations of these claims have been noted in the

rejection of claims 7 and 4 above. In addition, Cochran discloses the claimed feature of

"presenting the term to a user together with at least identifiers of a number of

documents or files stored in said system containing said term; presenting the term to a

user together with at least portions of a document identified by one of said identifiers"

(See Cochran. col. 7, line 10-Col. 9, line 59)', "said term is presented to a user with

portions of a document in a graphical user interface having a user activatable function

for adding a term to said document as a meta-tag" (See Cochran Figures 3a-9d and

corresponding text).

As per claims 11-12, most of the limitations of these claims have been noted in

the rejection of claim 7. Applicant's attention is directed to the rejection of claim 7 above.

In addition, Cochran disclose the claimed limitations of "providing an element for

selectively adding said term to said document as a meta-tag"; by allowing entry to be

made in the lists, thus, updating the lists (See Cochran Col. 12, lines 54-56). Notice

that the lists of Cochran (See Cochran Figures 3-10b) are multi-element data structure

that has a linear organization that allows elements to be added or remove. Thus, when

updating the lists, entries are made in the multi-element data structure. The Applicant

should duly note that a meta-tag is described in the specification (page 1 , lines 1 1-12)

as an entry in a meta-information section of a document or a file. As to the claimed

feature of "providing an element for adding information about the term added to said

d6cument as a meta-tag in an inverted index" Cochran achieved this limitation by

providing lists of search terms where the lists can be updated (See Cochran Figures 3-

10b). Thus, It would be apparent from Cochran's use of updating list that terms must be

added to an inverted index to effectively create alternative locators for the search terms

in the lists.

As per claim 13, all the limitations of this claim have been noted in the rejection

of claims 1-12. Namely, "providing an element for storing" and "providing an element for

adding". It is therefore rejected as set forth above.

As per claim 14, all the limitations of this claim have been noted in the rejection

of claims 1-12. Namely, "providing and element for generating a term", "providing an

element for generating a list" and using the list and the term for adding to documents

containing those terms as a meta-tag. It is therefore rejected as set forth above.

As per claims 15-17, all the limitations of these claims have been noted in the rejection of claims 14 as well as claims 2-3 including terms to be added as meta-tag. They are therefore rejected as set forth above.

As per claims 18-26, most of the limitations of these claims have been noted in the rejection of claims 1-12. In addition, Cochran discloses sorting query terms (See Cochran Figure 3D and corresponding text; eliminating noise words or stop words (Figure 3c and corresponding text). Also, claims 18-26 set forth features that are inherent to carry out the invention as detailed in the analysis above. Namely, providing an element for extracting terms used in search query is inherent in a database since the primary purpose of submitting a query to a database is to extract information associated with the submitted query. Presenting those terms to said server is also inherent since a query result must be presented to a user when a query is submitted to indicate to the user whether any document was found according the submitted query. As to a computer program product, Cochran provides apparatus, method as well as computer software for implementing the invention (See Cochran Title; Col. 5, lines 40-42).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 19, 20 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable

over Brunner et al. U.S. Patent no. 5,550,971 in view of Cochran.

As per claims 19-20 and 25, Brunner et al. teaching of a database management

system with adaptive user interface reads on the claimed features of "providing an

element for extracting terms and presenting those terms to a user; providing an element

for identifying a document containing a term; determining if the document contains

subject matter related to said term; and providing an element for adding said term to

said document as a meta-tag if it does; receiving a user selection of terms" (See

Brunner Abstract', and Col. 2, line 45-Col.3, line 22; Col. 4, lines 54-60).

It is noted, however Brunner et al. did not specifically detail the aspects of

adding the received terms to a document as a meta-tag. On the other hand, Cochran

achieved the aforementioned limitations by providing "a search of the database is

conducted based upon selected search terms" (2) "subset of records identified by the

search is used to form new list of search terms" and (3) "the matching records or hits

are added/stored at the server 710". As to the aspect of adding as meta-tag. Cochran

provides mechanism that allows terms added in the list to be viewed or access as meta-

tag because "FIG. 3b shows a list of search terms 211 that is displayed if the user

expands pick box 311 corresponding to the first list identifier 111, Start of Travel. Here,

there are five search terms 211 to choose from: January-March, April-June, July-

September, October-December and Disregard Start of Travel. The default search term,

January-March is highlighted and placed in the select box in order to indicate the search

term that will be selected if no other term is selected. If the user had previously selected

a term during a previous viewing of the search terms, that term will be highlighted as the

default term. Once a pick box 311 has been expanded, a search term 211 may be

selected by clicking on the desired search term 211 with the cursor (step 18). The

expanded pick box 311 will then close, leaving the selected search term 211 visible on

the display device (step 20). If the expand field icon 411 is activated without selecting a

search term 211, pick box 311 will close, leaving the default search term, January-

March visible on the display device, as shown in FIG. 3c". The most important part of

the description of Figure 3b, in another to understand the teachings of Cochran with

respect to meta tag or information about information, is ___a list of search terms 211 that___

___is displayed if the user expands pick box 311 corresponding to the first list___

___identifier 111 (Start of Travel)___. In this case, the first list identifier 111 (Start of Travel)

is the data that describes meta-data list of search terms 211 because when Start Travel

is selected the meta-data for a corresponding list of search terms are displayed within

the travel search database window.

It would have been obvious to modify the database management system of

Brunner et al. by incorporating the methodology of adding search terms to stored

information taught by Cochran. The motivation being, to allow the data management

system of Brunner et al to save computer resources, especially on-line transmission

resources, and makes searching more accurate and user-friendly.

Respons to Arguments

Applicant argued, "Independent claims 1 recites, inter *alia*:

to process the search queries against the stored information, and to provide a list

of terms used in the search queries presented over a period of time to be selectively

added to the stored information

Independent claim 4 recites, inter *alia*.

providing search access to the stored items in response to search queries

submitted by users, the server configured to provide a list of terms used in the search

queries over a period of time to be selectively added to at least one of the stored items."

In this line of argument, the Applicant stated that "Cochran fails to teach or

suggest at least the above-quoted elements of independent claims 1 and 4. The

Examiner states on page 4 of the Office Action that Cochran discloses . . .providing a

method for managing the presentation of search terms on a computer wherein multiple

lists of search terms are displayed, a search is conducted based upon selected search

terms from one or more of the multiple search lists, also, the records identified by the

search is used to form new lists of search terms (See Cochran Abstract; Col. 4, lines 1-

574 Figure 2 and corresponding text." However, the cited passages merely describe

that the search request is transmitted to the database . . . and the matching records . . .

are stored or marked . . . as a subset of records." (Col. 8: 45-50). "[t]he subset of

records is examined to created updated lists for the list identifiers that were not

originally searched. (Col. 8: 54-57). "To generate the correct lists. . . the computer

program identifies the search terms contained in each record of the subset of records

that has been generated from the first search." (Col. 8:66-Col. 9:4)

Cochran further discloses that "[t]he search terms are placed into an

alphabetical, chronological or numerical order and duplicate search terms are

eliminated." (Col. 9:4-7). "The newly generate lists are transmitted back to the user's

computer terminal." (Col. 9: 10-11). This however, is not a teaching or suggestion of at

least to process the search queries against the stored information, and to provide a list

of terms used in the search queries presented over a period of time to be selectively

added to the stored information," as recited in independent claim 1, nor is it a teaching

of suggestion of at least providing search access to the stored items in response to

search queries submitted by users, the server configured to provide a list of terms used

in the search queries over a period of time to be selectively added to at least one of the

stored items," as recited in independent claim 4. Therefore, Cochran fails to disclose at

least the above-quoted elements of Applicants' independent claims 1 and 4".

However, the Examiner disagrees with the preceding argument, because the

Applicant seems to read misinterpreted the Cochran reference. The cited portion of the

Office action pointed to specifics in the reference including the Abstract that specifically

recites that (1) "a search of the database is conducted based upon selected search

terms". (2) "subset of records identified by the search is used to form new list of search

terms" (See Cochran Abstract). Also, corresponding text of Figure 2, especially Col. 8,

lines 45-65, is clear and specifically recites that "The search request is transmitted to

the database 710 and then the identification number is appended to the search query at

step 30. The database is then searched for records having the selected search terms

32. The matching records, or "hits", are stored or otherwise marked as a subset of

records 34 at server 710. Database searching techniques and the identification of

subsets are well known, such as shown by the Cochran, et al. patents which have been

incorporated by reference above. At step 34, the subset of records is examined to

create updated lists for the list identifiers that were not originally searched in step 24

and to transfer the new lists to the user's computer. The creation of new search terms

may be done in the same manner as disclosed in the Cochran et al. patents,

incorporated by reference herein. For instance, in the current example, after a search

has been conducted based on search terms associated with list identifiers "Start of

Travel", "Number of People", and "Location", updated lists of search terms would then

be generated for each of the remaining list identifiers, "Lodging Type", "Lodging Name",

"Amenities" and "Price". In order to generate the correct lists at step 34, the computer

program identifies the search terms contained in each record of the subset of records

that has been generated from the first search 32. The search terms are placed into an

alphabetical, chronological or numerical order and duplicate search terms are

eliminated. The lists thus generated ensure that each search term will correspond to at

least one record in existence in the subset of records. The formation of current or

updated lists is further detailed in the Cochran, et al. patents, which have been earlier

incorporated by reference". The Examiner respectfully submits that because Cochran

shows that (1) "a search of the database is conducted based upon selected search

terms" (2) "subset of records identified by the search is used to form new list of search

terms" and (3) "the matching records or hits are stored at the server 710" is a clear

indication that Cochran discloses the claimed features of "to process the search queries

against the stored information, and to provide a list of terms used in the search queries

presented over a period of time to be selectively added to the stored information" as

well as "providing search access to the stored items in response to search queries

submitted by users, the server configured to provide a list of terms used in the search

queries over a period of time to be selectively added to at least one of the stored items".

The Applicant also argued, "Cochran fails to teach or suggest selecting at least a

portion of relatively high frequency search terms and processing each search term of

the portion for selective addition to documents or files stored in the system as a meta-

tag" and "processing the highest frequency terms as candidates for inclusion in

documents or files containing the terms as a meta-tag'" and that the Examiner failed to

address these elements in the Office action. The Examiner disagrees with the

preceding argument because the Office action specifically stated with respect to claims

7 and 18,

As per claim 7, most of the limitations of this claim have been noted in the

rejection of claims 1 and 4 above. In addition, Cochran discloses the claimed feature of

providing an element for storing a list of queries" and "an element for storing a list

terms" by providing memory spaces for retaining search request (See Cochran Col. 6,

lines 40-52). Also, Cochran discloses the claimed limitations of "providing an element

for selecting" (See Cochran Col. 7, lines 48-54). Last, Cochran discloses the claimed

limitations of "processing each term of said portion for selectively addition to documents

or files stored in said systems as a meta-tag" by allowing entry to be made in the lists,

thus, updating the lists (See Cochran Col. 12, lines 54-56). Notice that the lists of

Cochran (See Cochran Figures 3a-10b) are multi-element data structure that has a

linear organization that allows elements to be added or removed. Thus, when updating

the lists, entries are made in the multi-element data structure. The Applicant should duly

note that a meta-tag is described in the specification (page 1, lines 1 1-12) as an entry

in a meta-information section of a document or a file.

As per claims 18-26, most of the limitations of these claims have been noted in

the rejection of claims 1-12. In addition, Cochran discloses sorting query terms (See

Cochran Figure 3D and corresponding text; eliminating noise words or stop words

(Figure 3c and corresponding text). Also, claims 18-26 set forth features that are

inherent to carry out the invention as detailed in the analysis above. Namely, providing

an element for extracting terms used in search query is inherent in a database since the

primary purpose of submitting a query to a database is to extract information associated

with the submitted query. Presenting those terms to said server is also inherent since a

query result must be presented to a user when a query is submitted to indicate to the

user whether any document was found according the submitted query. As to a computer

program product, Cochran provides apparatus, method as well as computer software for

implementing the invention (See Cochran Title; Col. 5, lines 40-42).

Since, Cochran selected, processed and added all the terms and Cochran did

not make any distinction between the higher and lower term frequencies; therefore, at

one point in Cochran the highest frequency term is selected, processed and added to

the lists.

The Applicant further argued, Accordingly, the interpretation proposed by the

Examiner is unreasonable for at least two reasons. First, the specification states that

"meta-information is information about information. Some documents or files contain

sections which contain meta-information related to the contents of that document or file.

A meta-tag is an entry in a meta-information section of a document or file."

(Specification, page 1, lines 8-11). Therefore, in order for a document to have meta-

tags, it must have a meta-information section. The Cochran lists however, do not

contain a meta- information section, and as a result, cannot contain meta tags.

Second, a person skilled in the art of meta-information would readily understand

meta" as a word denoting a description that is one level of abstraction above the entity

being described." IEEE 100: The Authoritative Dictionary OJJEEE Standards Terms,

Institute of Electrical and Electronics Engineers, Inc. 2000, page 688. Therefore a meta-

tag, as described in the specification, is an entry in a meta-information section of a

document or a file, and it would describe the document or file that it is inserted into. The

Cochran lists, however, are merely a collection of search terms from many different

records, and after the search terms are gathered, they are put into one list. (col. 8:66-

col. 9:9). Therefore, in order for the entries in this list to meet the definition of meta-tag,

the would have to describe the document they are in, and in Cochran, the search terms

in this new list do not describe the document they are in, but rather correspond to at

least one record in existence in the subset of records." (Co1. 9:5-6). Cochran therefore,

fails to disclose "meta-tag" as recited in claims 7 and 18.

Therefore, Cochran fails to disclose at least the above-quoted elements of

Applicants' independent claims 7 and 18".

The Examiner respectfully disagrees with the Applicant's argument that Cochran

failed to disclose "meta-information" or information about information because in the

rejection of claims 7 and 18, the Examiner specifically pointed to Figures 3a-10b.

Figure 3b will be used, as an example, to explain how Cochran achieved meta-data or

meta tag or information about information. "FIG. 3b shows a list of search terms 211

that is displayed if the user expands pick box 311 corresponding to the first list identifier

111, Start of Travel. Here, there are five search terms 211 to choose from: January-

March, April-June, July-September, October-December and Disregard Start of Travel.

The default search term, January-March is highlighted and placed in the select box in

order to indicate the search term that will be selected if no other term is selected. If the

user had previously selected a term during a previous viewing of the search terms, that

term will be highlighted as the default term. Once a pick box 311 has been expanded, a

search term 211 may be selected by clicking on the desired search term 211 with the

cursor (step 18). The expanded pick box 311 will then close, leaving the selected

search term 211 visible on the display device (step 20). If the expand field icon 411 is

activated without selecting a search term 211, pick box 311 will close, leaving the

default search term, January-March visible on the display device, as shown in FIG. 3c".

The most important part of the description of Figure 3b in another to understand the

teachings of Cochran with respect to meta tag or information about information is ***a list***

of search terms 211 that is displayed if the user expands pick box 311

corresponding to the first list identifier 111 (Start of Travel). In this case, the first

list identifier 111 (Start of Travel) is the data that describes meta-data list of search

terms 211 because when start travel is selected the meta-data for a corresponding list

of search terms are displayed within the travel search database window.

Furthermore, the Applicant argued, with respect to Independent claims 13 and 23

that "Cochran fails to disclose at least the above-quoted elements of Applicants'

independent claims 13 and 23. Again, the Examiner has failed to address this feature of

claims 13 and 23 in the Office Action. For at least the reasons argued above. Adding at

least one term selected from the list based on frequency of occurrence to at least one

document containing the term as a meta-tag". However, the Examiner disagrees with

this line of argument because the Examiner specifically detailed:

As per claim 13, all the limitations of this claim have been noted in the rejection

of claims 1-12. Namely, "providing an element for storing" and "providing an element for

adding". It is therefore rejected as set forth above. Claim 23 was rejected among the

group of claims 18-26. Also, the argument for claims 7 and 18 applied to claims 13 and

23.

The Applicant argued, with respect to Independent claims 14 and 24 "using the master term list and the new term list as a source of terms for adding to documents containing the terms as a meta-tag" that Cochran fails to disclose at least the above-quoted elements of Applicants' independent claims 14 and 24. Again, the Examiner has failed to address the above-quoted elements of independent claims 14 and 24 in the Office Action. The Examiner disagrees with the preceding argument because the specifically detailed:

As per claim 14, all the limitations of this claim have been noted in the rejection of claims 1-12. Namely, "providing and element for generating a term", "providing an element for generating a list" and using the list and the term for adding to documents containing those terms as a meta-tag. It is therefore rejected as set forth above.

Claim 24 was rejected among the group of claims 18-26. Also, the argument for claims 7 and 18 applied to claims 14 and 24.

The Applicant argued, with respect to Independent claim 19 "presenting the extracted terms to the user; receiving a user selection of terms; and adding the received terms to a document as a meta-tag"; "for presenting the extracted terms to the user, for receiving a user selection of terms, and for adding the received terms to a document as a meta-tag" that "Cochran fails to disclose at least the above-quoted elements of Applicants' independent claims 19 and 25. While the Examiner notes on page 9 of the Office Action that as per claims 18-26, most of the limitations of these claims have been noted in the rejection of claims 1-12". Also, the above-quoted features of claims 19 and

25 were not addressed earlier in the Office Action with regard to the rejection of claims

1-12. The examiner disagrees with the preceding argument because aspects of

presenting extracted terms to a user, receiving a user selection and adding terms to a

document as meta- tag was shown in the rejection of especially claims 1, 7 as further

explained under the remark section of this office action.

Furthermore, the Applicant argued, Independent claim 20 recites, "determining if

the stored document contains subject matter related to the term; and selectively adding

the term to the document as a meta-tag"; Independent claims 21 and 26 recite,

"identifying documents or files containing at least one of said terms; and selectively

adding said at least one of said terms to said document or file as a meta-tag" and that

Cochran fails to disclose at least the above-quoted elements of Applicants' independent

claims 20, 21, and 26. As discussed with regard to independent claims 1 and 4, "[t]he

subset of records (in Cochran is examined to created updated lists for the list identifiers

that were not originally searched." (Co1. 8: 54-57). "To generate the correct lists. . . the

computer program identities the search terms contained in each record of the subset of

records that has been generated from the first search. The search terms are placed into

an alphabetical, chronological or numerical order and duplicate search terms are

eliminated." (Col. 8:66-Co1. 9:4). "The newly generate lists are transmitted back to the

user's computer terminal." (Co1. 9:10-11). This disclosure of Cochran, however, does

not constitute a teaching or suggestion of at least determining if the stored document

contains subject matter related to the term; and selectively adding the term to the

document as a meta-tag" as recited in independent claim 20, nor a teaching of at least identifying documents or files containing at least one of said terms; and selectively adding said at least one of said terms to said document or file as a meta-tag" as recited in independent claims 21 and 26. 26 are allowable, for at least the reasons argued above.

The Examiner respectfully disagrees with the preceding argument (See response to argument corresponding to claims 1 and 4 as well as response with respect to claims 7 and 18 above).

Last, Applicant's argument Regarding the rejection of claims 19, 20, and 25 under 35 U.S.C. 102(e) as anticipated by Brunner et al U.S. Patent 5,550,971 is moot because these claims are now amended and are rejected above under 35 U.S.C. 103(a).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The prior ad made of record and not relied upon is considered pertinent to applicant's disclosure.

Cochran et al. U.S. Patent no. 4,879,648 discloses a search system which continuously displays search terms during scrolling and selections of individually displayed data sets.

Cochran et al. U.S. Patent no. 5,768,581 discloses apparatus and method for selecting records from a computer database by repeatedly displaying search terms from multiple list identifiers before either a list identifier or a search term is selected.

Cochran et al. U.S. Patent no. 5,206,949 discloses database search and record retrieval system which, continuously displays category names during scrolling and selection of individually displayed search terms.

Sullivan et al. U.S. Patent no. 5,956,71 1 discloses database system which

restricted keyword list and bi-directional keyword translation.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Frantz Coby whose telephone number is 571 272 4017.

The examiner can normally be reached on Monday-Saturday 3:00PM-10:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Safet Metjahic can be reached on 571 272 4023. The fax phone number for

the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free).

Frantz Coby
Primary Examiner
Art Unit 2161

December 11, 2004